REMARKS

I. Overview

Claims 1-11 are pending in the present application. Claims 1 and 11 are amended herein. Applicant respectfully requests reconsideration of the claims in view of the following remarks.

The issues raised by the Examiner in the current Office Action dated September 4, 2008 (*Office Action*) are as follows:

- The Abstract is objected to as being more than 150 words;
- Claims 1, 6, 7 and 8-10 have been rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 3 and 5-7;
- Claims 1, 3-7 and 9-11 have been rejected under 35 U.S.C § 103(a) as assertedly being anticipated by U.S. Patent No. 5,732,213 to Gessel, et al. (hereinafter "Gessel") in view of WO 98/57268 to Swift, et al. (hereinafter "Swift"); and
- Claims 2 and 8 have been rejected under 35 U.S.C. § 103(a) as assertedly being unpatentable over Gessel in view of Swift and further in view of U.S. Patent No. 6,560,723 to Matsui (hereinafter "Matsui").

Applicant respectfully traverses the outstanding claim rejections and requests reconsideration and withdrawal in light of the amendments and remarks presented herein.

II. Amendments

The Abstract has been replaced with a new Abstract that has less than 150 words

Claims 1 and 11 have been amended. No new matter has been added by these amendments, which are supported by the original specification at least at Figures 4-7 and in the related disclosure.

III. Double-patenting Rejection

M.P.E.P. § 804 states:

> A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). . . . In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is - does any claim in the

> application define an invention that is anticipated by, or is merely an obvious variation of, an invention claimed in the patent? If the answer is yes, then an "obviousness-type" nonstatutory double patenting rejection may be appropriate. Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent, or a non-commonly owned patent but subject to a joint research agreement as set forth in 35 U.S.C. 103(c)(2) and (3), when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. . . .

(Citations omitted.)

The relevant question for the present application, as identified above, is: "does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the co-pending application?"

Independent claim 1, as amended, recites:

> f) defining within the communication data graphically a message to be received at the protocol tester from the device under test which contains a variable wherein the protocol tester performs one of several activities as a function of the content of the variable.

Independent claim 11, as amended, recites:

> means for defining within the communication data graphically a message to be received at the protocol tester from the device under test which contains a variable wherein the protocol tester performs one of several activities as a function of the content of the variable.

The Office Action acknowledges that these elements are not contained in the independent claims of the co-pending application 09/776,040. (Office Action at 3). The relevant analysis, for the present application, then becomes "is the addition of these elements merely an obvious variation on the invention claimed in co-pending application 09/776,040?" The Office Action fails to identify where these elements are found in the disclosure of the co-pending application. In fact, these elements are not found in the disclosure of the co-pending application. The Office Action further fails to explain why it would be obvious to modify the co-pending application to incorporate these elements.

Applicant submits that the incorporation of the above-recited "defining a message containing a variable" elements is not an obvious variation of the claims in the co-pending

application because that application does not support or enable these elements. Accordingly, the claims pending in the instant application would not be allowed or issued in the co-pending application under 35 U.S.C. § 112, first paragraph.

Because the pending claims could not be issued in the co-pending application, the pending claims do not attempt to extend the coverage of material disclosed in the co-pending application. Applicant submits that the claims are allowable over, and are not obvious in view of, the co-pending application and requests that the rejection based on nonstatutory obviousness-type double patenting be withdrawn.

IV. Rejection under 35 U.S.C. § 103

Independent claims 1 and 11 stand rejected under 35 U.S.C. § 103(a) as assertedly being unpatentable over Gessel in view of Swift.

A. The cited references fail to disclose messages containing a variable or performing one of several activities as a function of the content of the variable.

As noted above, independent claim 1, as amended, recites:

> f) defining within the communication data graphically a message to be received at the protocol tester from the device under test which contains a variable wherein the protocol tester performs one of several activities as a function of the content of the variable.

Independent claim 11, as amended, recites:

> means for defining within the communication data graphically a message to be received at the protocol tester from the device under test which contains a variable wherein the protocol tester performs one of several activities as a function of the content of the variable.

The Office Action admits that Gessel fails to disclose the "defining a message containing a variable" elements, but cites the Swift reference as disclosing these features. More specifically, the Office Action states:

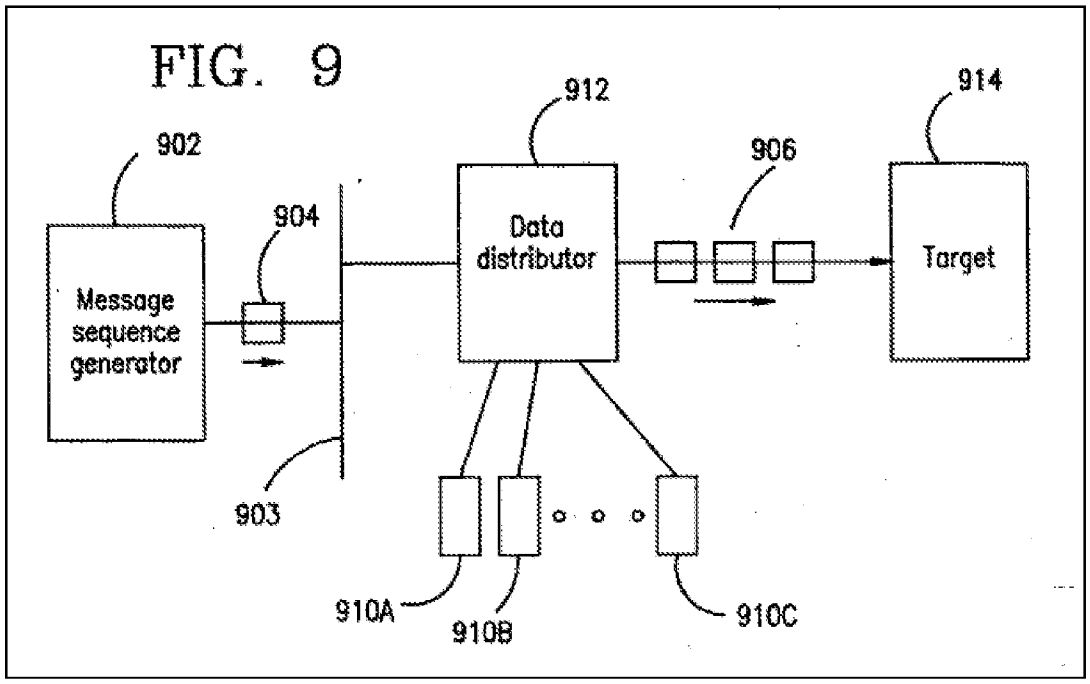
> . . . Swift discloses:
>
> defining a message from one instance to the other instance which contains a variable wherein the other instance performs one of several activities as a function of the content of the variable (page 18, paragraph 2)[target object 914 will perform the task based on the content of the received data]; . . . .

(Office Action at 5).

Paragraph 2 on page 18 of the Swift reference is copied below:

> FIG. 9 illustrates a test environment where time slices of data are transmitted to a target object 114. The test environment includes a message sequence generator 902, a data distributor 912, a TCP/IP communications network 903 for enabling the message sequence generator 902 to communicate with the data collector 912, one or more store forward files 910A-N, and a target object 914. Although only one message sequence generator, data distributor, and target object is illustrated, it should be appreciated by one skilled in the art that the test environment can include a plurality of message sequence generators, data distributors, and/or target objects.

Figure 9, which is referenced in the cited Swift paragraph and which contains the element "914" that was cited in the Office Action is reproduced below:



The cited paragraph fails to disclose a "variable" within a "message" that is sent between instances. Instead, Figure 9 (and the third paragraph on page 18) merely discloses sending

messages 906 from data distributor 912 to target 914. There is no teaching or suggestion in Swift that messages 906 can have "variables" or that any action is taken in target 914 based upon those "variables" as required in the pending claims.

The Office Action alleges that "target object 914 will perform the task based on the content of the received data;" however, there is no disclosure that such content is a "variable." Moreover, there is no disclosure that the task is "one of several activities [performed] as a function of the content of the variable."

B. The cited references fail to disclose sending messages between the claimed instances

The independent claims require "a message to be received at the protocol tester from the device under test."

There is no disclose in the cited Swift disclosure of messages sent between the claimed instances, which specifically require a "protocol tester" and "device under test." In Swift, message sequence generator 902 may correspond to the protocol tester, and target 914 may correspond to a device under test. However, messages are not sent between message sequence generator 902 and target 914 in Swift. Instead, Swift's command message 904 is sent from message sequence generator 902 to data distributor 912, which in turn sends a different set of messages 906 to target 914. (Swift at 18, third paragraph; Figure 9). Messages 906 are obtained from store forward files 910A-N. (*Id.*). Neither group of messages 904 or 906 pass the entire path between the message sequence generator 902 (protocol tester) and target 914 (device under test). Instead, these messages are exchanged only between either of the instances and the data distributor.

Furthermore, the messages in Swift are sent from the message sequence generator 902 (protocol tester) or to target 914 (device under test). The pending claims require that the message containing a variable be "received at the protocol tester from the device under test." Not only do the messages in Swift fail to traverse the entire path between the instances, but they do not flow in the direction required by the claim.

C. Conclusion

Claims 2-10 depend from independent claim 1 and add further limitations. It is respectfully submitted that these dependent claims are allowable by reason of depending from an allowable claim as well as for adding new limitations.

Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Applicant's attorney at 214-722-8983 so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,

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Date

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